The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY IRVING BLOOM

Appeal No. 2003-0697
Application 08/750,088

ON BRIEF

Before GARRIS, DELMENDO, and POTEATE, ***Administrative Patent Judges***.

PER CURIAM

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-8, which are all of the claims in the application.

The subject matter on appeal relates to air or a combination of air, liquids and solids which have been passed through a microwave active space. This appealed subject matter is adequately illustrated by independent claim 1, which reads as follows:

1. Air propelled through a microwave active space, said space encased in a microwave compatible material in the machine described willdisinfect [sic] the air.

The reference set forth below is relied upon by the examiner in the § 102 and § 103 rejections before us:

Condit et al. (Condit) 5,938,823 Aug. 17, 1999

All of the appealed claims stand rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellant regards as his invention.

All of the appealed claims also stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or alternatively under, 35 U.S.C. § 103(a) as being obvious over Condit.

Rather than reiterate the respective positions advocated by the appellant and by the examiner concerning the

above-noted rejections, we refer to the Brief and to the Answer for a complete exposition thereof.

OPINION

For the reasons which follow, we will not sustain the examiner's § 112, second paragraph, rejection of claims 1-8, but we will sustain the examiner's § 102 and § 103 rejections of claims 1-8.

On page 4 of the Answer, the examiner describes his position regarding the § 112, second paragraph, rejection with the following language:

> Claims 1-8 are narrative in form and replete with indefinite and functional or operational language. It is not even clear whether appellant is reciting a method or apparatus. The claims appear to merely recite air or any combination of air, liquid, and solids passing through a microwave active space enclosed in a microwave compatible material. The structure which goes to make up the device must be clearly and positively specified. All the appealed claims recite "the machine described" and therefore appear to be omnibus claims. Such claims are indefinte [sic] because they fail to point out what is included or excluded by the claim language.

The inquiry under the second paragraph of § 112 is to determine whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed, not in a vacuum but, always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. ***In re Moore***, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

In so analyzing the language of the appealed claims, we find that the area or subject matter defined by these claims has been set out and circumscribed with a reasonable degree of precision and particularity. Specifically, we agree with the examiner's aforequoted acknowledgment that "[t]he claims appear to merely recite air or any combination of air, liquid, and solids passing through a microwave active space enclosed in a microwave compatible material."

This analysis or interpretation of the appealed claims is consistent with the literal wording or language of these claims. Further, this claim interpretation is reasonable and

consistent with the appellant's specification disclosure. ***See In re Sneed***, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Finally, it is significant that the appellant has not disagreed with this claim interpretation on the record before us.

In light of the foregoing, it is our determination that the claims on appeal comply with the second paragraph of § 112 by particularly pointing out and distinctly claiming the subject matter which appellant regards as his invention. This subject matter includes air or a combination of air, liquids and solids propelled or passed through a microwave active space as recited in these claims. It follows that we cannot sustain the examiner's § 112, second paragraph, rejection of claims 1-8.

We reach a different conclusion with respect to the § 102 and § 103 rejections of claims 1-8 over Condit. As correctly explained by the examiner in the Answer, a microwave active space is included in the apparatus and process of Condit. As a consequence, the air as well as airborne liquids and solids which are passed through this apparatus are treated in such a manner as to sterilize and/or disinfect microorganisms contained in the air, liquids and/or solids. In this way, the air as well

as airborne liquids and solids carried thereby are caused to be disinfected, filtered, purified and/or sterilized. In these respects, see Condit's teachings at, for example, lines 13-33 in column 1, the paragraph bridging columns 1 and 2, the paragraph bridging columns 2 and 3, as well as lines 37-48 in column 4.

Under the circumstances recounted above, the here-claimed products of air or a combination of air, liquids and solids appear to be indistinguishable from the corresponding products yielded by the process and apparatus of Condit. It is appropriate to here emphasize that, even though the appealed claims are product-by-process claims (i.e., the claims define the aforementioned products via the process by which they are made), the determination of patentability is based on the product itself. ***In re Thorpe***, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). That is, if the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***Id.*** Here, the process by which the appellant's claimed products are made appears to be the same as the process by which Condit's air and other products are made.

Nevertheless, even if these processes were different, the appealed claims would remain unpatentable since the products defined thereby are indistinguishable from those of Condit. ***Id.***

It is the appellant's fundamental argument that the prior art rejections based on Condit are improper because it is the appellant rather than Condit who is the true inventor of the subject matter defined by the appealed claims and disclosed in the Condit patent. However, the record of this appeal does not contain adequate probative evidence in support of this argument. We are constrained, therefore, to regard the appellant's argument as unpersuasive.

For the reasons set forth above and in the Answer, we hereby sustain the examiner's § 102 and § 103 rejections of claims 1-8 based on Condit.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

BRADLEY R. GARRIS Administrative Patent Judge	)	
ROMULO H. DELMENDO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LINDA R. POTEATE Administrative Patent Judge	)	

BRG:psb

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